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| 09/544,329      | 04/06/2000  | AKIHIKO TAKAHASHI    | 105914              | 7938             |

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OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

MILLER, MARTIN E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2623

DATE MAILED: 07/03/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

7

# Office Action Summary

Application No.

09/544,329

Applicant(s)

TAKAHASHI, AKIHIKO

Examiner

Martin Miller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on April 7, 1999.

### ***Drawings***

2. The Examiner has found the drawings filed April 06, 2002 acceptable.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims use phrase "sets of inherent information", which is a general phrase, but as used in claim 9 is confusing because of the modifying phrase "at least one set of" (line 5). As used in the claim, it is unclear whether applicant only wants to update if both sets of inherent data matches or if three or more sets of inherent information can match? Applicant is requested to clarify the meaning of the "at least one set of" and the "as long as" terminology used in claim 9.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by

Steinberg et al. (hereinafter Ste818), US 6433818.

As per claim 1, Ste818 teaches:

an image-capturing element that captures an image of a subject and generates electronic image information (camera, fig. 1, element 10);

a recording device that records the electronic image information that has been generated in a recording medium(fig. 6A, element 100);

a registration device that registers inherent information with respect to a registrant (fig. 12, col. 5, ll. 39-41);

an information detection device that detects inherent information with respect to a user of the electronic image-capturing apparatus (fig. 12, fig. 13, element 12);

an information verification device that references the inherent information with respect to the user detected by said information detection device with the inherent information registered in said registration device (fig. 13, element 208, col. 5, ll. 43-53); and

a control device that allows an image-capturing operation to be performed on the electronic image-capturing apparatus (fig. 13, element 210) if it is decided by said information verification device that the two sets of inherent information match (col. 5, ll. 48-53).

As per claim 2, Ste818 teaches:

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a digital watermarking device that adds (fig. 6A, element 98) information related to the inherent information detected by said information detection device to the electronic image information that has been generated as a digital watermark.

As per claim 4, Ste818 teaches:

said registration device enables additional registration of information inherent to another registrant (iris information) via said information detection device if said information verification device detects an previously registered registrant (subsequent users, col. 6, ll. 10-15).

As per claim 5, Ste818 teaches:

a selection device (col. 4, ll. 20-32) that selects a limited user mode that limits users of the electronic image-capturing apparatus or an unlimited mode that does not impose any restrictions on users of the electronic image-capturing apparatus, wherein;

said control device implements control to ensure that only the registrant for whom the two sets of inherent information (Both iris and epidermal, col. 8, ll. 40-43) have been verified to match by said information verification device is allowed to operate said selection device.

As per claim 6, Ste818 teaches:

wherein the inherent information is registrant's fingerprint information (col. 6, ll. 32-35, col. 7, ll. 58-67); and said information detection device is constituted of a sensor that detects fingerprint information (fig. 12).

As per claim 7, Ste818 teaches:

a grip used by the user to hold the electronic image capturing apparatus while capturing an image of a subject (col. 6, ll. 29-35), wherein

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said sensor is provided at a position at which a finger of the user is naturally placed when the user holds said grip (col. 6, l. 33, fig. 10).

As per claim 8, Ste818 teaches:

a registration control device that deactivates said information verification device if it is decided that information with respect to user detected by said information detection device is not registered at all in said registration device (col. 5, ll. 45-50), and

registers said inherent information detected by said information detection device in said registration device (col. 5, ll.60-62).

As per claim 9, Ste818 teaches:

said registration control device prohibits updating (it prohibits all use, col. 5, ll. 45-50) of contents of information registered in said registration device if it is decided there is at least one set (claim allows for two sets) of inherent information registered in said registration device as long as said information verification device does not decide that two sets of inherent information match (col. 8, ll. 36-43).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ste818.

As per claim 3, Ste818 teaches:

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a power control device having a switch to be set at a recording position, a reproduction position or an OFF position, that controls power ON/OFF (fig. 1, element 28, is an example of an on/off switch, but most cameras also have an onboard on/off switch); But Ste818 does not specifically teach that the switch remaining in a particular position is a permit condition. However, Ste818 teaches:

said control device allows an image-capturing operation to be performed on the electronic image-capturing apparatus without requiring said information verification device to operate as long as said switch remains at said recording position (e.g permit condition, col. 4, ll. 13-33) after said information verification device decides that the two sets of inherent information (both iris and epidermal, col. 8, ll. 40-43) match when said switch is at said recording position.

It would have been obvious to one of ordinary skill in the art to include in the permit conditions of Ste818 the turning of the camera on/off or changing the mode function of the camera to further limit the options of the rental user or provide another charging option for the owner renting the camera. Since Ste818 teaches that his camera is completely programmable such a feature could easily be implemented.

As per claim 10, Ste818 does not teach allowing use when user authorization fails, however, Ste818 teaches:

wherein said control device allows a reproduction operation regardless of results of verification performed by said information verification device when the electronic image information recorded in said recording medium is reproduced. Steinberg discloses a camera that is programmable. It would have been obvious to one of ordinary skill in the art not to require biometric verification in all picture-taking situations by programming the camera for use in

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particular situations. For instance, if you were at a large extended family gathering or if you were somewhere foreign and you wanted a stranger to take your picture in front of a landmark, you would not want to take the time to register your entire extended family or each stranger in order to quickly take the picture. The photo opportunity may pass by the time you register the unknown user.

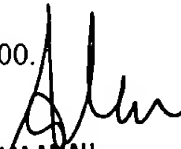
### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U.S. patent(s) refer(s) to devices with cameras and biometric detection: Wang, 6038333, Kuno, 6067624, Schmitt et al., 6088585, Robb, 6177950 B1. The following U.S. patent(s) refer(s) to biometric registration/enrollment/verification devices: Teitelbaum, 5872834, Chai 6563939, and Yamaguchi et al., 6314196 B1. The following PCT publication refer(s) to in-camera encryption: Steinberg et al., WO 97/36426.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Miller whose telephone number is (703) 306-9134. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
AMELIA M. AU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

MEM  
6-28-03